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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,589	03/17/2004	Ronald Bruce Hawkins	50T5731.01	3873

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EXAMINER	
STRONCZER, RYAN S	

ART UNIT	PAPER NUMBER
4157	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/802,589	HAWKINS ET AL.	
	Examiner	Art Unit	
	Ryan Stronczer	4157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-20 and 22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-20 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

Applicant's arguments filed January 11, 2008 have been fully considered but they are not persuasive.

With respect to claim 1, Applicant alleges (Remarks, page 7) that the reference "*fails to mention [third party marketing data and demographic data].*" Examiner respectfully disagrees. As cited in the previous Office Action, paragraph 0011 of Pontenzone teaches, "...the content delivery management system comprises a reporting module that compiles data based on song content delivered by each of the one or more stations, including data relating to the popularity of specific content with listeners of the stations." Examiner maintains that the data based on song content delivered by each station is the equivalent of the recited third party marketing data and thus is consistent with the subject matter recited in claim 1. As to the recited demographic data, the paragraph 11 of Pontenzone teaches that the reporting module collects data "relating to the popularity of specific content with listeners of the stations." Given that Pontenzone's system allows for a plurality of listening stations which can be targeted to a specific market or genre, the preference of listeners of a various stations for specific content delivered by those stations can be reasonably interpreted as demographic data consistent with that recited by claim 1.

In response to applicant's arguments regarding claims 5 and 13 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the reference *"uses metadata for billing"*) are not recited in the rejected claim(s). Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner notes that claims 5 and 13 recite that the metadata is *"used to indicate a billable event,"* but that the claim language fails to recite that the metadata is involved in the billing process.

In response to applicant's argument that Hempleman et al. fails to use the term "metadata," the prior art rejection is based on the combination of Pontenzone in view of Hempleman as a whole and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner also notes that the term "metadata" is used extensively by Pontenzone.

With respect to claim 8, Applicant alleges that the steps of the method taught by Asmussen et al. are executed in a different order from the recited method and that this difference renders the claimed subject matter patentably distinct, Examiner notes that the prior art rejection is based on the combination of Pontenzone in view of Asmussen as a whole and that such combination would provide the same playlist-generation functionality as recited in claim 8. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Pontenzone et al. (Pub. No. US 2002/0152278).

Claims 1-4 are rejected for the same reasons set forth in the previous Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5, 6, 13, 14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pontenzone et al. as applied to claims 1-4 above, and further in view of Hempleman et al. (US Patent No.: 6,243,725).

Claims 5, 6, 13, 14, and 21 are rejected for the same reasons set forth in the previous Office Action.

Claims 7-12, 15, 17-20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pontenzone as applied to claims 1-4 above, and further in view of Asmussen et al. (Pub. No.: US 2002/0042923).

Claims 7-12, 15, 17-20, and 22 are rejected for the same reasons set forth in the previous Office Action.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pontenzone as applied to claim 1 above, and further in view of Asmussen et al. and Hempleman et al.

Amended Claim 16 recites the network recited in the original claim, but has been amended to include, *"means for allowing a user to select a title from the playlist; and means for billing the user for downloading content associated with the title if metadata associated with the title indicates a billable event."* As applied to claim 16 in the previous Office Action, Pontenzone in view of Asmussen provides the functionality to generate a playlist as recited in claim 16. Regarding the amended subject matter in claim 16, Pontenzone in view of Hempleman, as applied to claims 5 and 13 in the previous Office Action provide the recited functionality. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the purchasing functionality taught by Hempleman with the playlist-generation functionality taught by Pontenzone and Asmussen to facilitate the purchase of content suggested by Pontenzone and Asmussen.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Stronczer whose telephone number is (571) 270-3756. The examiner can normally be reached on 7:30 AM - 5:00 PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan Stronczer/
Examiner, Art Unit 4157

/Vu Le/
Supervisory Patent Examiner, Art Unit 4157